



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

09/147,861 03/17/99 NISHIKATA

K TOYAM42.001A

020995 HM12/1022
KNOBBE MARTENS OLSON & BEAR LLP
620 NEWPORT CENTER DRIVE
SIXTEENTH FLOOR
NEWPORT BEACH CA 92660

EXAMINER

PULLIAM, A

ART UNIT

PAPER NUMBER

1615

DATE MAILED:

10/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/147,861

Applicant(s)

NISHIKATA ET AL.

Examiner

Amy E Pulliam

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Receipt is acknowledged of the Amendment B and the Request for Extension of Time, both received August 13, 2001.

Claim Rejections - 35 USC § 112

The rejection of claims 7 under 35 U.S.C. 112, second paragraph has been withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,246,780 to Farer *et al.*. Farer *et al.* disclose coated particles for use in cosmetic preparations. More specifically, Farer *et al.* teach that one embodiment of their invention is spherical particles having a first coating material applied to the particles, which is a coupling agent selected from the group consisting of silanes and titanates, and thereafter applying a second coating material to the particle (c 2, l 19-30). Farer *et al.* also teach that although the preferred coating is boron nitrate, other suitable coatings are acceptable, including silicone powders, zirconium dioxide, and titanium

Art Unit: 1615

dioxide, and combinations thereof (c 3, l 57 – c 4, l 3). Additionally, Farer *et al.* teach the use of their coated particles in cosmetic preparations. Therefore, the disclosure of Farer *et al.* anticipates applicant's claims.

Response to Arguments

Applicant's arguments filed August 13, 2001 have been fully considered but they are not persuasive. Applicants argue that the Farer *et al.* reference fails to anticipate the claimed invention because Farer *et al.* do not disclose a coated powder which is defined by a combination of refractive indices of the component parts. Applicant further argues that the section at column 3, line 57 to column 4, line 13 is simply a laundry list of compounds with diverse structural features and chemical properties, and does not teach the specific combination claimed by applicant. The examiner respectfully disagrees. As stated in the above rejection, Farer *et al.* teach a particle, which has a first coating, which is a coupling agent selected from the group consisting of silanes and titanates, followed by a second coating of a material other than a coupling agent (c 2, l 20-26). Further, Farer *et al.* teach that acceptable coating materials include silicon powders, zirconium dioxide, and titanium dioxide. This clearly anticipates applicant's claimed invention. It is unimportant that the coating materials are found in a list of possible coating materials, as this still teaches that Farer *et al.* recognize zirconium dioxide and titanium dioxide as acceptable coating materials. Additionally, it is unimportant that the materials within the list of possible coatings have different chemical and structural properties, because Farer *et al.* teach that they are all successful, and the

reference specifically teaches applicant's claimed materials. Furthermore, although Farer *et al.* do not disclose the refractive indices of the specific materials, this is an inherent characteristic, and as the reference teaches applicant's claimed materials, they inherently teach the claimed refractive indices.

Applicant also argues that Farer *et al.* do not teach the method step recited in claims 6 and 7. The examiner respectfully disagrees as the method steps in these claims are very broad.

For these reasons, the above rejection is maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farer *et al.*. Farer *et al.* are discussed above as teaching coated particles for use in cosmetic preparations, wherein the particles can be coated more than once. Farer *et al.* is also discussed above as disclosing the same components for the coatings as claimed by applicant. Farer *et al.* does not teach the refractive index of the components in the particle composition. However, because Farer *et al.* teach the same components (silica, zirconia, and titania) as those claimed by applicant, it is the position of the

Art Unit: 1615

examiner that the refractive indexes are inherent to these components, and therefore must fall within the range claimed by applicant.

Further, as stated above, Farer *et al.* does teach that the preferred embodiment is particles coated with boron nitrate, they also state that other suitable coatings are acceptable, including silicone powders, zirconium dioxide, and titanium dioxide, and combinations thereof (c 3, l 57 – c 4, l 3). Therefore, Farer *et al.* do teach all of the limitations of applicant's claimed invention. Based on the teachings of Farer *et al.*, one of ordinary skill in the art would have made coated particles for use in cosmetic preparations, comprising spherical particles with a first coating of a silane or titanate, and a second coating layer chosen from many possibilities, including titanium dioxide, zirconium dioxide, and silicon powders. The expected result would be a coated spherical particle which could be used to provide excellent aesthetic properties in a cosmetic preparation such as powders, mascaras, blushes, liquid makeups, and other well known cosmetic formulations. Therefore, this invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Response to Arguments

Applicant's arguments filed August 13, 2001 have been fully considered but they are not persuasive. Applicants argue that there is no guidance in the reference to achieve applicant's claimed invention with a reasonable expectation of success. The examiner respectfully disagrees. The guidance lies in Farer's teaching that there are several successful coating materials for the composition. One of ordinary skill in the art

would have been motivated to use any of the listed coating materials, based on the teachings of Farer *et al.*. This rejection is maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy E Pulliam whose telephone number is (703) 308-4710. The examiner can normally be reached on Mon-Thurs 7:30-5:00, alternate Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on (703) 308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

Application/Control Number: 09/147,861

Page 7

Art Unit: 1615

305-3592 for regular communications and (703) 305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

aep
October 17, 2001


THURMAN K. PAGE
SUPERVISOR PATENT EXAMINER
TECHNOLOGY CENTER 1600